

***Remarks***

Applicant respectfully requests reconsideration of this application.

Upon entry of the foregoing Amendment, claims 1-4, 10 and 16-19 are pending in this application, with claims 4 and 10 being withdrawn from consideration. Of the pending claims under consideration, 1 and 17 are independent. Claims 5-9 and 11-15 have been canceled by the foregoing or a previous Amendment. Claims 1-3 are sought to be amended by this Amendment, and claims 16-19 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Applicant submits that entry of this Amendment is proper, in that (1) some of the finally rejected claims have been canceled, (2) the claims now comply with the requirements of 35 U.S.C. § 112, first and second paragraphs, as well as Applicant's election of species, and (3) the finally rejected claims are in better condition for appeal.

Based on the above Amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and withdraw the same.

***Acknowledgement of Telephone Interview***

Applicant would like to thank the Examiner for the courtesy extended to its representative during the recent telephone interview. The discussion aided Applicant in amending the claims of the application and addressing the rejections of the final Office Action.

***Description of the Invention***

Applicant's invention relates to a magnetic stop or latch for a door. The invention is uncomplicated and effective, in that it relies quite simply on the attractive and repulsive forces of two magnets for the purposes of (1) preventing a door from slamming against a wall, (2) holding a door in a stationary, open position or (3) latching a door in a stationary, closed position. The invention comprises a first magnet provided on a door and a second magnet provided on a surface of a structure opposite the door. The first or second magnet is received by and within a magnet holder, which allows a user to selectively move one of the magnets from a position of attraction with respect to the other magnet (to keep the door open or in a latched condition, for example), to a position of repulsion with respect to the other magnet (to prevent a door from swinging open and slamming into a wall, for example). While the magnet holder is fixedly mounted to either the door or opposing structure, the magnet received therein can be selectively moved or repositioned within and with respect to the magnet holder, to position the magnet in an attractive or repulsive position vis-à-vis the other magnet.

***Rejections under 35 U.S.C. § 112***

The Examiner has rejected the claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, in that the claims contain subject matter not described in such a way to convey to one skilled in the art that Applicant had possession of the claimed invention, at the time the application was filed.

Claims 1-3, 5, 7, 8, 10 and 12-15 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly

claim the subject matter Applicant regards as the invention. More particularly, with respect to claims 1-3, the Examiner has taken the position that it is not clear what the scope of the claims should include, as the elected embodiment of Figures 4 and 6 is not described or shown to have a magnet holder that allows rotatable movement of a magnet or movement with respect to and within the magnet holder. *See* final Office Action, page 2, paragraph 3.

As a result of the telephone interview, Applicant understands the position taken by the Examiner, but asserts that the claims, as hereby amended are definite, enabled and do, in fact, read on the species elected by Applicant. On November 17, 2004, the Examiner issued a requirement for election of species, taking the position that the application contained claims directed to several patentably distinct species. In addition to other groups, the Examiner identified the species of Group II as a magnet mounted onto a door's surface, as illustrated in Figures 4 and 6 of the application. *See* Requirement for Election of Species, paragraph 1. In a telephone call with the Examiner on December 8, 2004, Applicant's representative advised that the species of Group II illustrated a magnet mounted onto a door (as in Figure 4), as well as a magnet mounted onto a structure opposite a door (as in Figure 6). The Examiner confirmed for Applicant's representative that he would interpret the species of Group II to cover both a magnet mounted onto a door and a magnet mounted onto a structure opposite a door.

Applicant elected the species of Group II, in that Figures 4 and 6 thereof, illustrate the general concept of Applicant's invention: that is, a magnetic stop or latch for a door having a first magnet mounted onto a door, a second magnet mounted onto an outside surface of a structure opposite the door, and means (e.g., a magnet holder) to

allow the user selectively move one of the magnets (disposed within the means) into an attractive or repulsive position with respect to the other magnet. More particularly, Figure 4 illustrates, generally, how the first magnet of the invention is mounted on a door, while Figure 6 illustrates, generally, how the second magnet is mounted on the outside surface of a structure opposite a door (particularly, a baseboard). *See* paragraphs [0014] and [0016] and paragraphs [0032] and [0033]. While neither figure illustrates the structure of the claimed magnet holder *per se*, Applicant submits that one of ordinary skill in the art would appreciate that magnet holders 728,828,928 illustrated in Figures 7-14, for example, are inherently encompassed by and in the elected species, in that magnet holders 728,828,928 are described and illustrated as being mounted *onto a door* or an *outside surface of a structure of a door* (such as a baseboard), as disclosed generally in Figures 4 and 6. *See* paragraph [0034], lines 3-6; paragraph [0035], lines 9-10; paragraph [0036], line 8; paragraph [0037], lines 3-5; and Figures 7-14. Indeed, magnet holders 728,828,928 are alternate embodiments of each other, and each are employable with a magnet on a door or on a structure opposite a door, as shown in Figures 4 and 6 of the elected embodiment. Applicant also notes that the structure of Figure 18 is disclosed as being mounted onto a door, akin to the structure of Figure 4. *See* [0044], line 2-3.

Taking all of the above assertions and specification and figure references into account, Applicant asserts that the claims, as hereby amended, are enabled, definite and read on the species elected by Applicant.

With respect to claims 5, 7, 8 and 12-15, the Examiner asserts that the scope of the claims is not clear, as the elected embodiment does not disclose a "first magnet in the edge surface of the door" and a "second magnet...mounted in the surface of the

doorframe...." Applicant has canceled claims 5, 7, 8 and 12-15 by this paper and asserts that the rejection, as applied to such claims is now moot.

Further, the Examiner has indicated that inasmuch as the term "selecting means" is not used in the specification, it is not clear what structure of the elected embodiment is being referred to to perform the recited function. By this paper, Applicant has amended the claims of the application to replace the term "selecting means" with "magnet holder". Applicant submits that this term is fully described in and supported by the specification. For example, the recited magnet holder and structure thereof is discussed in paragraphs [0034]-[0038] and is illustrated, for example, in Figures 7-14.

If the Examiner finds Applicant's arguments in response to the rejection under Section 112, first and second paragraphs, unpersuasive, Applicant respectfully requests that the Examiner allow Applicant to shift its previous election of Figures 4 and 6 to election of a species having a first magnet mounted on a door, a second magnet mounted on a structure opposite a door, and a magnet holder for receiving either the first or second magnet that enables a user to selectively move the magnet within the holder from a repulsive position with respect to the other magnet, to an attractive position. While Applicant acknowledges that the Office generally does not permit shift, (M.P.E.P. § 819), Applicant submits that the Examiner has already conducted a search for the broadly defined invention and species of currently amended claim 1, as claim 1 (as originally filed and rejected by the Examiner in the non-final Office Action dated May 4, 2004) also recited a magnetic door stop having a first magnet mounted on a door, a second magnet mounted on a structure opposite a door and a magnet holder. Having

already searched the invention and species of currently amended claim 1, Applicant submits that a shift of election would cause the Examiner no additional burden.

***Allowable Subject Matter***

Due to the nature of the rejection of the final Office Action, the Examiner made no indication of allowable subject matter. Having shown that the claims of the application, as hereby amended, comply with the requirements of Section 112, first and second paragraph and read on the elected species, Applicant submits that the pending claims under consideration meet the requirements for patentability and are allowable.

With respect to the art of record, Applicant submits that independent claim 1 and the claims depending therefrom are patentable, in that none of the applied art discloses or suggests a magnetic door stop having a first magnet mounted *on a door*, a second magnet mounted *on the surface of a structure opposing the door*, and a magnet holder which receives either the first magnet or the second magnet, where the magnet holder allows a user to *selectively move within the magnet holder* one of the first magnet or the second magnet between a first position of repulsion between the first and second magnets and a second position of attraction between the first and second magnets.

Similarly, nothing in the art of record teaches or suggests a magnetic door latch for a door comprising a first magnet, a second magnet mounted *on an outside surface of a structure opposing the door*, and a magnet holder mounted *on the door* to receive the first magnet, where the magnet holder is connected *to an assembly to allow a user to selectively and rotatably move the first magnet* between a first position of attraction between the first and second magnets and a second position of repulsion between the

first and second magnets. Accordingly, Applicant submits that the claims, as hereby amended, are patentable and in condition for allowance.

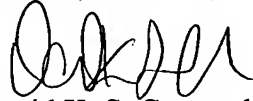
### ***Conclusion***

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and withdraw the same. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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Date: June 9, 2006

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